

REMARKS

The Examiner has objected to claims 15, 37 and 39 for informalities. The Examiner has rejected claims 18, 40 and 62 under 35 U.S.C. §112, Second Paragraph. Lastly, the The Examiner has rejected claims 15 through 18, 37 through 40 and 59 through 62 under 35 U.S.C. §102(e). In view of the above claim amendments and the following remarks, the Applicant respectfully submits to the Examiner to reconsider the pending rejections and objections.

The Claim Objections

The Examiner has objected to claims 15, 37 and 39 for informalities. However, it appears that the Examiner meant claim 59 instead of claim 39 for the informality objection. Accordingly, claims 15, 37 and 59 have been amended as the Examiner has kindly suggested. The Applicant respectfully submits to the Examiner that the claim objections should be withdrawn.

The Section 112, Second Paragraph Rejections

The Examiner has rejected claims 18, 40 and 62 under 35 U.S.C. §112, Second Paragraph for the lack of proper antecedent basis. Accordingly, the claims have been amended to correct the antecedent bases. The Applicant respectfully submits to the Examiner that the claim rejections under 35 U.S.C. §112, Second Paragraph should be withdrawn.

The Section 102(e) Rejections

The Examiner has rejected claims 15 through 18, 37 through 40 and 59 through 62 under 35 U.S.C. §102(e) as allegedly being anticipated by the Delinger et al. reference. With respect to the previous arguments filed by the Applicant, the Examiner has responded on page 9 of the pending Office Action that the Delinger et al. reference “teaches a selectivity value corresponding to the highest selectivity value among the N libraries” and “the word with the highest selectivity value (among the libraries) would be chosen for a search.” The Examiner further indicated that “the selectivity values are library-specific (0169) to also describe a relationship between the search input and a database to be searched.” Unfortunately, the Examiner did not respond to the Applicant's argument that the use of certain portions of the Delinger et al. reference may not be qualified under 35 U.S.C. §102(e).

Currently pending independent claims 15, 37 and 59 each explicitly recite “determining a database occurrence value based upon the first text database occurrence value and the second text database occurrence value in a predetermined manner so that the word candidates substantially more occurring one of the first text database and the second text database but substantially less occurring in the other of the first text database and the second text database are avoided in the search words” and “the first text database containing certain vocabulary and sentences written in a certain style that are substantially different from those in the second text database.” [emphasis added]. In other words, the invention as explicitly recited in currently pending independent claims 15, 37 and 59 avoids in the “search words” certain “word candidates” that appear more frequently in one text database but less frequently in the other database to be searched.

In view of the above explicitly recited patentable features, the applicants understand the disclosures of the Dehlinger et al. reference in the following manner. Despite the characterization by the Examiner, the Dehlinger et al. reference does not appear to disclose every subject matter limitations of previously dependent claims 15, 37

and 59. For example, the Examiner has cited Paragraphs [0163] for allegedly anticipating the following patentable feature, “the word candidates substantially more occurring in one of the first text database and the second text database but substantially less occurring in the other one of the first text database and the second text database are avoided in the search words.” To support the allegation, the Examiner has stated that “each word in the descriptive word database is associated with a selectivity value corresponding to the highest selectivity value among the N libraries” on page 4 of the Office Action. Furthermore, the Examiner has stated that “[t]he descriptive words are given a selectivity value which is based upon their occurrence in each library” on page 9.

The Dehlinger et al. reference generally discloses a “text-processing” and search system and method to search certain words of interest in text databases or libraries. Initially, databases or libraries are generated from “processed text,” which includes a list of non-generic words and text, library, text-specific word-specific identifiers associated with each word. (Paragraphs [0076] and [0077]). In addition, each words also has a selectivity value reflecting “the frequency occurrence in a library of text in a selected field, relative to the frequency of occurrence of the same word in one or more other libraries of text in one or more other fields.” (Paragraph [0078]). The database generally contains “descriptive words” having a selectivity value above a predetermined threshold value. (Paragraph [0081]). After certain generic words and verb roots are removed from input text to generate non-generic words or target text, a search is made using the remaining terms having a selectivity value above a predetermined threshold value against the above described databases or libraries. (Paragraphs [0085] through [0087]).

The cited references fails to anticipate certain patentable feature of the current invention as explicitly recited in currently pending independent claims 15, 37 and 59. For example, the cited references fails to anticipate the avoidance of the words having the highest selectivity value in a search input. Currently pending independent claims 15, 37 and 59 calls for “the word candidates substantially more occurring in one of the first text

database and the second text database but substantially less occurring in the other one of the first text database and the second text database [to be] avoided in the search words.” [emphasis added]. Although the Dehlinger et al. reference discloses “patents” and “case reporters” as databases, no disclosure is provided for avoiding “the word candidates substantially more occurring in one of the first text database and the second text database but substantially less occurring in the other one of the first text database and the second text database.”

As supported by the original disclosures on pages 12 through 14 of the current application under examination, the second preferred embodiment of the current invention two databases containing different vocabulary and styles such as a patent database and a newspaper database. (lines 28 and 29, page 12). Although the word frequency occurrence is small in one database, it is generally considered as useful as a search word, “the database occurrence determination unit 33 takes into account a difference in the occurrence value between the first text database 31 and the second text database 32 in determining the significance value.” (lines 12 through 14, page 13). Consequently, the current invention provides that “a search word is not likely selected from words that are used frequently in the first text database 31 but are not frequently used in the second text database 32.” (lines 10 through 12, page 14).

The Examiner may refer to the fact that the Dehlinger et al. reference discloses multi-tier search strategies for suggesting the above patentable feature of the current invention. Only when the search results are not encouraging, the second-tier and or the third-tier searches are conducted using the words that were not initially used in the first search. (Paragraphs [0099] through [0101]). (Paragraphs [0180] and [0181]). These portions of disclosure are irrelevant to the patentable features of the current invention since the disclosure is related to the operations after the search words are already selected and tried. Quite contrarily, the patentable feature teaches away from this strategy of the subsequent multi-tier searches by “avoid[ing] the inclusion of certain “word candidates”

in the “search words.”

In addition to the above clear reasons for overcoming the pending section 103 rejections, the applicant would like to bring the following issues to the Examiner’s attention on the use of the Dehlinger et al. reference as prior art.

The Dehlinger et al. reference is a US Patent Publication (US 2004/0006558 A1) (herein after also referred to as “the 558 publication”). The 558 publication has issued as US Pat 7,181,451 (the 451 patent) on February 20, 2007. According to the Public PAIR, the 558 publication is published from US application 10/261,971 (the 971 application) filed on September 30, 2002, which appears to have claimed on the transmittal letter priority from its provisional application No. 60/394,204 (the 204 parent provisional application) filed on July 5, 2002. On the other hand, the public PAIR also indicates the executed declaration refers to “PART C” for claiming the benefit under 35 U.S.C. §120, but no PART C appears to exist in the prosecution record. The 971 application also claims that it is a continuation of PCT Patent Application No. PCT/US02/21198 (the first PCT parent application) filed on Jul. 3, 2002 and a continuation of PCT Patent Application No. PCT/US02/21200 (the second PCT parent application) filed on Jul. 3, 2002.

The 558 publication has added additional disclosures on new matter over the 204 parent provisional application, the first PCT parent application and the second PCT parent application. For example, new matter includes alternative searches or the multi-tier searches, which were not disclosed in any of the 204 parent provisional application, the first PCT parent application or the second PCT parent application. Thus, the newly added disclosures do not gain the benefit of priority claim from the 204 parent provisional application, the first PCT parent application and the second PCT parent application. The current US application under examination was filed on August 28, 2003 claiming the benefit of foreign priority of Japanese patent application 2002-250281

filed on August 29, 2002. The 971 application for the 558 publication was filed on September 30, 2002 after the current US application under examination. Since the 971 application contains newly added disclosures, the Dehlinger et al. reference cannot claim the benefit of priority for certain newly added disclosures including the multi-tier searches. For this reason, the Dehlinger et al. reference does not qualify as prior art for disclosing or teaching the multi-tier searches.

In view of the above patentable distinction, even if the two cited references are combined, the applicants respectfully submit to the Examiner that the combined disclosures still fail to teach, disclose or suggest the explicitly recited subject matter limitations of currently pending independent claims 15, 37 and 59. Thus, it would not have been obvious to one of ordinary skill in the relevant prior art to provide the above discussed patentable features of currently pending independent claims 15, 37 and 59 based upon the cited references alone or in combination.

Dependent claims 16 through 18, 38 through 40 and 60 through 62 ultimately depend from currently pending independent claims 15, 37 or 59 and incorporate the patentable features of the currently pending independent claims. Therefore, the applicants respectfully submit to the Examiner that the rejections of pending claims 15 through 18, 37 through 40 and 59 through 62 under 35 U.S.C. §102(e) as allegedly being anticipated by Dehlinger et al. should be withdrawn.

Conclusion

In view of the above amendments and the foregoing remarks, Applicant respectfully submits that all of the pending claims are in condition for allowance and respectfully request a favorable Office Action so indicating.

Respectfully submitted,

/KEN I. YOSHIDA/

Ken I. Yoshida, Esq.

Reg. No. 37,009

Date: February 6, 2008

KNOBLE YOSHIDA & DUNLEAVY LLC

Customer No. 21302

Eight Penn Center, Suite 1350

1628 John F. Kennedy Blvd.

Philadelphia, PA 19103

Telephone: (215) 599-0600